

## REMARKS

Claims 1-5 remain pending in this patent application.

### ALLOWABLE SUBJECT MATTER

Applicant notes with appreciation the Examiner's recognition of allowable subject matter in claims 2, 4 and 5. For reasons presented below, Applicant submits that claims, as presented herein, are allowable.

### ENTRY OF AMENDMENTS TO THE CLAIMS

In this paper, Applicant is proposing amendments to claims 1 and 3. As explained below, the amendments to these claims make use of language inferentially suggested by the Examiner. Applicant submits that the amendments to claims 1 and 3 place these claims in condition for allowance. Accordingly, Applicant respectfully requests that the Examiner permit entry of these amendments.

### PRIOR ART REJECTION I

Claim 1 stands rejected under 35 USC § 102(b) as being anticipated by US 5611723 (Mitoma et al.). Applicant respectfully traverses this rejection.

In this paper, Applicant is proposing an amendment to claim 1, whereby the claimed method will affirmatively recite the processing direction as inclined to the seam.

In the Final Rejection, the Examiner observed that the claims did not "require a processing direction that is inclined to the seam" and that Applicant's arguments relating to the inclination of the processing direction were therefore misplaced and not persuasive. Applicant is construing this commentary by the Examiner as an invitation to amend claim 1 to positively recite the processing direction as inclined and thereby define patentably over the applied prior art. In this paper, Applicant is proposing such an amendment to claim 1.

In the Reply filed in this application on October 10, 2006, Applicant observed that the golf ball manufacturing method recited in claim 1 includes a combination of steps including an attitude regulating step and a seam processing step. In the attitude regulating step, a golf ball is oriented so that the seam of golf ball with a spew on the seam is placed in a predetermined

position. In claim 1 as presented herein, in the seam processing step, while the golf ball is rotated in the circumferential direction of the seam, the spew or seam is subjected to cutting or grinding by means of a rotary processing tool having a processing direction that is inclined to the seam. As explained in the specification of this application, golf balls made using the steps recited in claim 1 exhibit superior properties compared to golf balls made according to known prior art methods.

The Mitoma et al. machine for removing burrs from a golf ball includes an attitude modifying apparatus 100 and a grinding apparatus 200. At stations ST0 through ST5 of the attitude modifying apparatus 100, a golf ball is oriented so that burrs formed on the equator of the ball are positioned in a horizontal plane. At station ST9 of the grinding apparatus, a golf ball with burrs oriented in a horizontal plane is rotated about a vertical axis and is brought into contact with rotary cutter 47, which removes the burrs. See column 10, lines 12-22. The only disclosure in Mitoma et al. relating to the attitude of the cutter is provided by Fig. 1, which shows the cutter mounted for rotation about an axis that is parallel to the (vertical) rotational axis of the golf ball. From the foregoing observations, it is apparent that Mitoma et al. discloses a golf ball de-burring machine that can be fairly characterized as performing the attitude regulating step recited in Applicant's claim 1. It is also apparent that, in the Mitoma et al. grinding apparatus 200, the cutting or grinding performed by cutter 47 occurs in a plane that is coincident with or parallel to the plane in which the burrs on the golf ball are positioned. There is no disclosure or suggestion in Mitoma et al. of a cutting or grinding operation performed by a "rotary processing tool having a processing direction that is inclined to the seam while rotating the golf ball in a circumferential direction of the seam," as clearly recited in claim 1.

In view of the foregoing observations, Applicant submits that the disclosure in Mitoma et al. cannot properly serve as a basis for rejecting claim 1, as presented herein, under 35 USC § 102(b).

#### PRIOR ART REJECTION II

Claim 3 stands rejected under 35 USC § 103(a) as being unpatentable over Mitoma et al. in view of US 3073072 (Selby). Applicant respectfully traverses this rejection.

For reasons explained above in connection with the proposed amendment to claim 1, Applicant is proposing amendments to claim 3, whereby the claimed method will affirmatively recite the processing direction as inclined to the seam.

Applicant submits that, in view of the amendments to claim 3 as proposed herein, Applicant's arguments relating to this rejection, as presented in the October 10, 2006 Reply, are relevant and persuasive. Accordingly, these arguments are included in the discussion below.

In the statement of this rejection, the Examiner characterizes Mitoma et al. as teaching "the basic claimed process" including "a first processing step of cutting or grinding the spew or the seam by means of a rotary processing tool having a processing direction to be inclined to the seam while rotating the golf ball in a circumferential direction of the seam." As Applicant makes clear above, Mitoma et al. does not disclose such a processing step in which the processing direction is inclined to the seam, as required by claim 3 as amended herein.

The Examiner acknowledges that the disclosure in Mitoma et al. cannot meet the requirement in Applicant's claim 3 for a second processing step performed "by means of a rotary processing tool having a processing direction to be inclined to the seam and to cross the processing direction at the first processing step with the seam interposed therebetween while rotating the golf ball in the circumferential direction of the seam." As a remedy for this deficiency of the Mitoma et al. disclosure vis-à-vis the requirements of Applicant's claims, proposes modifying the Mitoma et al. grinding process so that it performs grinding in crossing directions, as taught by Selby.

In the Selby apparatus, a grinding wheel 2 performs surface grinding on a workpiece supported on work table *d*, which is movable under the grinding wheel in two mutually orthogonal directions that are parallel to the rotational axis of the grinding wheel. There is no disclosure or suggestion of performing grinding on a spherical work piece, such as a golf ball, much less a spherical work piece that rotates as it is ground. From the foregoing observations, it is apparent that the teachings in Selby would not have been obviously applicable to the deburring operation performed by the Mitoma et al. apparatus, as proposed by the Examiner, and that any combination of teachings in Mitoma et al. and Selby could not yield an apparatus that could perform the steps required by Applicant's claim 3.

In view of the foregoing observations, Applicant submits that no reasonable combination of the disclosures in Mitoma et al. and Selby can properly serve as a basis for rejecting claim 3, as presented herein, under 35 USC § 103(a).

#### CONCLUSION

In view of the amendments, observations and arguments presented herein, Applicant respectfully requests that the Examiner reconsider and withdraw the rejections stated in the outstanding Office Action and recognize all of the pending claims as allowable.

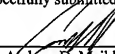
If unresolved matters remain in this application, the Examiner is invited to contact Frederick R. Handren, Reg. No. 32,874, at the telephone number provided below, so that these matters can be resolved expeditiously.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: April 26, 2007

Respectfully submitted,

By

  
Andrew D. Meikle

Registration No.: 32,868

BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road  
Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000  
Attorney for Applicant